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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/506,795	02/18/2000	Alain Bethune	05725.0533-00000	8040

7590

01/02/2002

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EXAMINER

SHORTSLE, KEVIN P

ART UNIT

PAPER NUMBER

1734

DATE MAILED: 01/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

MFE 8

**Office Action Summary**

Application No.

09/506,795

Applicant(s)

BETHUNE ET AL.

Examiner

Kevin P. Shortsle

Art Unit

1734

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --****Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-75 is/are pending in the application.
- 4a) Of the above claim(s) 7,11,13,15,17-19,36-72,74 and 75 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,8-10,12,14,16,20-35,73 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election of Group I, claims 1-35, 72-73 in Paper No. 7 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 36-71 and 74-75 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected invention, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 7.
3. Applicants election of species resulted in an election of all the species presented in the Restriction Requirement (Paper No. 6) dated September 21, 2001. Applicant elected A1, B2 and B3 and therefore elected claims 3-6, 12, 73 (A1), 14 and 20 (B2) and 16 (B3). Applicants election of A1 included claims drawn to non-elected species A2 and A3, the election of B2 included claims drawn to non-elected species B1 and A3, and the election of B3 included claims drawn to non-elected species B1 and A2. The generic claims are 1-2, 8-10 and 21-35. It is noted that generic claims are generic to all the species or groups of species.
4. Claims 7, 11, 13, 15, 17-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a non-elected species, there being no allowable

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generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 7.

***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-6, 8-10, 12, 14, 16, 20-35, 73 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for applying at least one piece of material from each surface onto an object and applying pieces of material from each surface onto objects, does not reasonably provide enablement for applying one piece of material from either surface to a plurality of objects. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims. Claim 1 does not limit the instance where one piece of material from the first surface is applied to a plurality of objects, and likewise applying one piece of material from the second surface to a plurality of objects, which is not enabled by the specification.

8. Claims 1-6, 8-10, 12, 14, 16, 20-35, 73 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear how one piece of

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material from the first surface is applied to a plurality of objects, and likewise it is unclear how a piece of material from the second surface is applied to a plurality of objects.


### ***Conclusion***

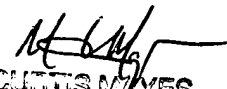
9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. USPNs 5705024, USPN 4314869 and 3861986 are cited to show similar conventional methods of applying pieces of material to objects.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin P. Shortsle whose telephone number is 703-308-8193. The examiner can normally be reached on M-F, 8-4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard D. Crispino can be reached on 703-308-3853. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
K. P. Shortsle  
December 31, 2001

  
CURTIS M. HAYES  
PRIMARY EXAMINER